UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 27

Application Number: 09/388,926
Filing Date: September 02, 1999
Appellant(s): MA ET AL.

Christian C. Michel, Reg. No. 46,300
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01 August 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2)   Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and

interferences which will directly affect or be directly affected by or have a bearing on the

decision in the pending appeal is contained in the brief. Therefore, it is presumed that

there are none. The Board, however, may exercise its discretion to require an explicit

statement as to the existence of any related appeals and interferences.

(3)   Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4)   Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

(5)   Summary of Invention

The summary of invention contained in the brief is correct.

(6)   Issues

The appellant's statement of the issues in the brief is correct.

(7)   Grouping of Claims

The appellant's statement in the brief that certain claims do not stand or fall

together is not agreed with because the appellant does not provide a statement why the

dependent claims are separately patentable. Therefore, the appropriate grouping is 1-9

and 19, 10-12 and 20, and 13-18.

(8)   Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   Prior Art of Record

5,790,935	PAYTON	8-1998
6,363,440	STEPP et al.	3-2002
5,757,909	PARK	5-1998
6,272,535	IWAMURA	8-2001

(10)   Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payton, U.S. Patent No. 5,790,935 in view of Iwamura, U.S. Patent No. 6,272,535, Park, U.S. Patent No. 5,757,909 and Stepp et al., U.S. Patent No. 6,363,440.

As per claims 1-20, Payton teaches a virtual on-demand digital information delivery system comprising:

- a receiver that receives an encrypted digital signal (audio, video or other) (column 1, lines 15-27; column 4, lines 55-67; column 5, lines 55-67)

- memory for storing an encrypted digital signal (column/line 2/64-3/9; column 6, lines 1-19)

- a recorder for recording onto a recording medium (column 6, lines 20-50; column 8, lines 11-25)

- a recording medium player (figure 5; column 6, lines 20-50; column 8, lines11-25)

- plurality of recording mediums that record deciphered digital signals (column 6, lines 20-50)

- combined player and recorder (column 6, lines 20-50)

- decryption of encrypted signal (column 6, lines 1-20)

- storing encrypted digital signals in a memory device as it is being received (column 4, lines 55-67; column 6, lines 1-20 and 44-50)

Payton does not explicitly recite a buffer connected to a receiver or determining whether the beginning of a signal is in the buffer and recording the signal if the beginning is present. Stepp et al. teach a signal recording method and apparatus comprising: a buffer connected to a receiver for storing at least a portion of the signal (figure 1; column 1, lines 42-59; column 4, lines 1-32), determining whether the beginning of a signal is present in said buffer and a user recording the signal to a recording medium if the beginning of the desired signal is present (figure 3; column 4, lines 32-56; column 5, lines 1-45). However, neither Payton nor Stepp et al. teach payment cards. Iwamura teaches a user terminal for receiving digital content, where the terminal is associated with an accounting apparatus (figure 8). Iwamura also teaches an accounting apparatus that deducts

value from a card (e.g. smart, pre-paid, credit, debit...etc.) that stores monetary

credits (column 5, lines 24-30; column 6, lines 10-30), determines whether a card

has sufficient value and allows a user to add value to the card in order to access

data (column column/line 5/24-6/37). While Park teaches encryption keys and

utilizes smart cards to decrypt digital signals transmitted to a user terminal

(column 1, lines 5-26 and 44-55; column 2, lines 31-37; column/line 3/62-4/17;

column 4/55-5/5; column 6, lines 29-67; column/line 7/65-8/16; column/line 9/64-

10/15; column/line 11/53-12/10; column 13, lines 22-29). Therefore, it would have

been obvious to combine the teachings of Payton, Stepp et al., Iwamura, and

Park. Payton teaches delivering digital information to users ('935, figure 2). By

implementing the system of Payton with the teachings of Stepp et al., users can

record, " ... a program in its entirety from the beginning even though the decision

to record the program occurs after the program occurs after the program starts

and has been broadcast for a non-zero duration. ('440, column 1, lines 11-28)"

Payton also teaches user payment for downloaded digital items ('935, column 4,

lines 64-67), therefore, it would have been obvious to pay for access using the

smart card of Iwamura as he teaches an accounting apparatus using a card to

pay for access to digital data ('535, column 1, lines 5-17), such as content that

the user decides to record to a medium from a buffer ('440, figure 3; column 4,

lines 32-56; column 5, lines 1-45). Payton and Iwamura also teach that digital

data should be encrypted to prevent illegal or unauthorized usage ('935, column

4, lines 60-67; '535, column/line 15/24-16/56). Hence, using smart cards to store

encryption keys would lead to increased efficiency as it combines data security

('909, abstract) with a method for obtaining, or paying, for digital content.

(11) Response to Argument

The Appellant is of the opinion that the Examiner's rejection was improper as the

references do not teach receiving a signal that already has embedded data operable to

allow determination of the actual start time of a broadcast segment. The Appellant

agrees with the Examiner that the Stepp et al. reference explicitly recites "an information

signal which may include information regarding the content of the information signal...

for example, the time at which the information signal is initially broadcast (i.e. start time)

may be encoded into the information signal" (Brief on Appeal, page 5, lines 19-22; '440,

column 4, lines 32-35). The Appellant then attempts to distinguish the Appellant's

system from the explicit recitation of the Stepp et al. reference by stating that Stepp et

al. "does not distinguish when the information is embedded..." (Brief on Appeal, page 5,

lines 22-24). However, this is also explicitly taught by Stepp et al., as the Stepp et al.

reference teaches that the information signal may be encoded with length of the signal,

start time, title, etc. and that the receiver ('440 figure 2) receives the information signal

and decodes the signal in order to determine the encoded information ('440, '440, figure

2; column 4, lines 1-30 and 32-42). Therefore, the Appellant's characterization of the

Stepp et al. teaching that the receiver that inserts the start time into the signal is

inaccurate. Note, if this were the case, then the receiver of Stepp et al. would not have

any reason to decode the signal to determine, for example broadcast start time.

In considering the Appellant's Declaration (paper no. 23) the Appellant declares

that "Standard radio and television signals do not contain embedded data related to

contemporaneous program segments" (paper no. 23, page 2, item 5 and page 3, item

9). However, in light of the Stepp et al. teaching this is not the case, as Stepp et al.

clearly teach embedding data related to contemporaneous program segments in the

signal prior to reception by a receiver ('440, column 4, lines 1-42). The Appellant's have

not presented an argument detailing why one of ordinary skill, given the explicit

teachings of Stepp et al., *would not* embed another signal, such as an audio signal, with

information. The Declaration does not express a "long-felt need", and certainly, in light

of the teachings of Stepp et al., does not bring to light the "inoperability of the prior art"

nor "unexpected results". Note, the claims merely recite "digital audio radio service"

however, the Declaration refers to SDARS or satellite DARS or satellite digital audio

radio service, therefore it is proper to give the claim language "digital audio radio

service" its broadest reasonable interpretation (*In re Pearson*, 181 USPQ 641 (CCPA

1974)) that of digital audio transmissions such as the signals transmitted using the

system of Payton ('935, column 6, lines 20-25).

Regarding a "reason to combine", Payton, Stepp et al., Iwamura and Park each

are directed to obtaining and processing digital information. Payton teaches transmitting

digital information to a user ('935, figure 2). It would have been obvious to modify the

Payton system using the buffering system of Stepp et al. ('440, figure 2) as it allows

users to record, " ... a program in its entirety from the beginning even though the

decision to record the program occurs after the program occurs after the program starts

and has been broadcast for a non-zero duration" ('440, column 1, lines 11-28). Iwamura

teaches a method and system for allowing users to pay a service provider for delivering

digital information service using a smart card that stores monetary credits (column/line

5/24-6/37). Payton and Iwamura teach encrypting information signals to prevent

unauthorized access to digital information. ('935, column 4, lines 60-67; '535,

column/line 15/24-16/56). Therefore, it would have been obvious to combine Park with

Payton, Stepp et al., and Iwamura, as Park teaches a method for decrypting digital

signals transmitted to a user terminal using smart cards (column 1, lines 5-26 and 44-

55; column 2, lines 31-37; column/line 3/62-4/17; column 4/55-5/5; column 6, lines 29-

67; column/line 7/65-8/16; column/line 9/64-10/15; column/line 11/53-12/10; column 13,

lines 22-29).

(12) Conclusion

Appellant's arguments are not persuasive in that they incorrectly

characterize the teachings of Stepp et al., as Stepp et al. specifically recite

embedding a digital signal with start time and other contemporaneous program

segments related to the digital signal ('440, column 4, lines 1-42). Further, the

Appellant does not give fair credit to the level and knowledge of those of ordinary

skill, and what a person of ordinary skill would consider obvious in light of the

teachings of Stepp et al. regarding the broadcasting of digital signals to a user.

For the above reasons, it is believed that the rejections should be

sustained.

Respectfully submitted,

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October 10, 2003

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